

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application, and for the personal interview conducted on February 21, 2007, with the Examiner and her supervisor. The application has been carefully reviewed in light of the Office action and interview, and this response provided thereto.

The Examiner has rejected claims 83-104 under the doctrine of judicially created obviousness-type double patenting. However, this rejection should be withdrawn, for the following reasons.

Initially, applicant disputes that the claims in this case are obvious with respect to the claims in the cited application(s). However, this issue is moot considering the point below.

MPEP §804(I)(B) states that:

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. *If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent*, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

(emphasis added; see also MPEP §1504.06). The section goes on to state that "the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent" (emphasis added). Thus, it is clear that the proper procedure is to issue the first case that is ready to issue, especially if it is the first filed case, and, if necessary, to maintain a double patenting rejection in the remaining case(s).

Under the facts herein, this case is the earlier filed case which has allowed claims, and the cited application was filed subsequently. Thus, under the MPEP, the provisional rejection should clearly be held in abeyance.

Consequently, by the above argument and according to proper procedures of the MPEP, the Examiner should withdraw the double-patenting rejection in the case that is first in a condition for allowance, and issue a notice of allowance, without the filing of a terminal disclaimer in that case, which is not necessary.

The Examiner has also rejected the claims for obviousness-type double patenting in light of patent number 7,134,074 (serial number 09/785,063). The rejections are traversed for the following reasons:

Patent number 7,134,074 is a continuation-in-part of this application. Thus, the '074 patent has matter that is not disclosed in this application, which may be reflected in the claims.

The Examiner has not provided a proper rejection for obviousness-type double patenting in light of the '231 application. MPEP §804(II)(B)(1), second paragraph, states that:

A double patenting rejection of the obviousness-type is “analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103” except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Accordingly, the Examiner is required to make the following factual inquiries required by MPEP §804(II)(B)(1), paragraphs 3-7:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

The rejection is also required to make clear the following (MPEP §804(II)(B)(1) 8th paragraph):

- (A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

The Examiner has failed to make the proper factual inquiries and has failed to show the differences between the inventions defined by the conflicting claims or identify any reasons why one skilled in the art would find such differences to be obvious. Accordingly, the Examiner has not made a proper rejection for Obviousness-type double patenting. Consequently, although the Applicant asserts that the claims in the application are not obvious in light of the reference, applicant cannot respond to the rejections because applicant is not cognizant of what is considered the obvious elements. Therefore, the Examiner must either withdraw the rejections, or provide the required factual inquiries and analysis in support of the rejection.

Claims 83-104 remain in this application. Claims 1-83 have been canceled. The examiner has acknowledged that claims 101-104 are directed to allowable subject matter, subject to resolution of the double-patenting rejection.

The Examiner requests that the specification be amended to refer to applications that are later filed continuation or CIP applications (i.e., “child” applications) that are based upon this application. Applicants are aware of no requirement for such a reference, and thus prefer not to do so. The Examiner should cite any authority supporting such a requirement.

Claims 83-84, 86-93, and 95-100 were rejected under 35 U.S.C. §103(a) as being unpatentable over Smith *et al.* (Video Skimming...Techniques, IEEE 1997). Claims 85 and 94 were similarly rejected as being unpatentable over Smith in combination with Yeo

et al. (U.S. 5,821,945). For the following reasons, the rejections are respectfully traversed.

Claim 83 recites a data processing apparatus comprising an input unit and an output unit, where the input unit is:

operable to input content description data including a plurality of segments each for describing one of said plurality of scenes of media content, said content description data also including a plurality of importance attributes each associated with a corresponding one of said plurality of segments, said importance attributes having a value representing a degree of contextual importance of said corresponding one of said plurality of segments

and where the output unit is “operable to output at least one of said segments based on at least one of said importance attributes”. Smith does not teach any such apparatus.

The Examiner cites various features in Smith that appear to be steps of a method for aiding a user for intelligently skimming video (see the Introduction section 1.0). However, as discussed at the personal interview, there is no teaching of any *device* having an *input unit* as specified above, or having an output unit as specified above. In particular, there is no teaching of any device having an input unit which can input “content description data” as defined in claim 83.

Applicant notes that the claim is not directed toward a method or process, but to an apparatus, and that the reference provides no teaching of any apparatus. In fact, the cited reference appears to be a paper describing research providing a method of intelligent skimming of video (see Abstract and Conclusion). Furthermore, the reference discloses method step that are *manually* performed. See the Abstract of Smith, and Section 3.5 (first sentence), which clearly states that the skims described by the reference are “manually created”. Furthermore, Smith only describes an *algorithm* to create skim videos (see Conclusion), not any *apparatus* with the features recited in the claim.

Furthermore, even if the reference teaches a method that is performed by the claimed apparatus (although applicant does not so concede, as the reference does not

teach such a method), there is no legal means to prohibit the claims from being patentable over the reference. The structure of the claimed apparatus must be taught by the prior art, not merely the method being performed by the claimed apparatus. Yeo fails to overcome the shortcomings of Smith. Accordingly, claim 83 is patentable over the reference, as are claims 84-91, which depend on claim 83, directly or indirectly.

In addition, the Examiner admits in the Office action, as was discussed at the personal interview, that Smith does not teach an “importance attribute” that has a “value representing a degree of contextual importance of said corresponding one of said plurality of segments” as recited in claim 83. Instead, the Examiner cites section 3.3 of the reference as teaching that “with prioritized video frames from each scene, we not have a suitable representation for combining the image and audio skims for the final skim.” Nothing in this quoted material, or in the cited section, however, discusses any feature that might be considered an “importance attribute” having a “value”, as recited by the claim language. Applicant notes that this “value” must represent “a degree of contextual importance”, and there is nothing that can be considered such a “value” found in the cited section (or anywhere else in the paper). The Examiner fails to provide any argument as to why the cited section makes providing such an attribute obvious to one skilled in the art. Thus, the Examiner has not made a *prima facie* case of obviousness (the requirements of which are outlined at the end of these remarks), and thus the claim is patentable over the reference.

Yeo fails to overcome the shortcomings of Smith. Thus, for this reason as well, claim 83 is patentable over the reference, as are claims 84-91, which depend on claim 83, directly or indirectly.

Similarly, claim 92 recites a method comprising the steps of

inputting content description data including a plurality of segments each for describing one of said plurality of scenes of media content, said content description data also including a plurality of importance attributes each associated with a corresponding one of said plurality of segments...

where the plurality of importance attributes have a “value representing a degree of contextual importance of said corresponding one of said plurality of segments”. Thus,

claim 92 is patentable over the references for reasons similar to those discussed directly above for claim 83, as are claims 93-100, which depend, directly or indirectly, upon claim 92.

Finally, the Examiner has not provided the proper motivation or rationale for modifying the base reference. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP §2142). To support a *prima facie* case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the base reference (MPEP §2143.01). The prior art must also suggest the desirability of the combination (*Id.*). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish *prima facie* obviousness (*Id.*).

The Examiner has cited no support for any such suggestion or rationale for modifying Smith to include the attribute of the claims. Furthermore, the Examiner has not provided the proper motivation for combining Smith with Yeo, as merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

Accordingly, the rejections for obviousness are not supported by the Office action and thus the rejections are improper, and should be withdrawn.

Finally, at the personal interview the Examiner requested clarification of the function of outputting the segments. The claims refer to content description data including a “plurality of segments each for describing one of said plurality of scenes of media content”. Thus, the outputted segments are part of the description data, not the media content. See, for example, Figure 1, which shows separate inputs of media and description data. Also note Figure 2, which shows a breakdown of an embodiment of the description data with “segments” shown at the lowest level. Hopefully, this explanation will clarify this matter for the Examiner.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32161.

Respectfully submitted,
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